

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:	Atty. Docket No.: 004770.00787
<b>Christian Kraft</b>	
Serial No.: 09/921,127	Group Art Unit: 2617
Filed: August 3, 2001	Examiner: Peaches, Randy
For: A METHOD OF ENTERING CHARACTERS INTO A TEXT STRING AND A TEXT-EDITING TERMINAL USING THE METHOD	Confirmation No.: 6446

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Box AF**

U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

Applicant respectfully requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

***Remarks***

Having received and reviewed the final Office Action dated April 16, 2008, and the Advisory Action dated August 25, 2008, Applicant respectfully submits that the standing rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005.

The pending rejections fail to address all the claim limitations, and exhibit clear factual and legal errors with respect to the cited references. The specific errors relied upon in this Pre-Appeal Brief Request for Review include the following:

- The Office erred in its combination of King and Walker in rejecting claims 1, 4-14 and 16 under 35 U.S.C. §103(a), as argued in the response filed July 16, 2008, at pp. 6-8. For example, claims 1, 5, 7 and 14 all relate to a key becoming a dedicated scroll key when in an editor mode. The Office Action dated April 16, 2008, concedes at p. 3 that the combination of Walker and King fails to clearly state that the dedicated key is a scrolling key. Instead, the Office Action asserts that Tsuji discloses this feature at col. 10 lines 33-45. However, even assuming Tsuji describes a dedicated scroll key, the Office continues to ignore the additional features of claims 1, 5, 7 and 14, notably that the key *becomes* a dedicated scroll key *when in an editor mode*. As mentioned in Applicant's January 7, 2008 Response to the Office Action of October 10, 2007, the dedicated scroll keys described in Tsuji are permanently "dedicated" to scrolling regardless of when or why they are being used, thus excepting them from *becoming dedicated* scroll keys in a particular mode. Stated differently, a scroll key cannot *become* dedicated for scrolling if it is always dedicated for scrolling. Thus, even if properly combinable, the asserted combination of Tsuji with the editing mode described in King would not result in the features recited in claims 1, 5, 7 and 14. Instead, the alleged combination would provide a permanent scroll key regardless of mode. The Advisory Action dated August 25, 2008, does nothing to address to these shortcomings. In view of the above, King, Walker and Tsuji all clearly fail to teach or suggest a key becoming a dedicated scroll key, much less becoming a dedicated scroll key when in an editor mode. Accordingly, claims 1, 5, 7 and 14 and their respective dependent claims are allowable for at least these reasons.
- Additionally, Applicants respectfully submit that claim 15 is improperly rejected under 35 U.S.C. §103(a) as being unpatentable over King, Walker, Tsuji and Heie (U.S. Patent No. 6,473,621, "Heie"). As noted in Applicant's response dated July 16, 2008, the present application and Heie were, at the time the invention was made, owned by, or subject to an obligation of assignment to Nokia Corporation or wholly owned subsidiary thereof. Accordingly, based on the Statement of Common Ownership submitted in the response dated July 16, 2008, Heie is not

applicable prior art for a rejection under 35 U.S.C. §103(a). Notably, the Advisory Action dated August 25, 2008, fails to address Applicant's Statement of Common Ownership and remarks in the same regard.

While Applicant believes the above points represent the clearest errors made by the Office, Applicant reserves the right to appeal on other bases and errors. In addition, Applicant believes the rejections of other claims not identified above are also based on one or more Office errors. Applicant will address such issues on appeal should the appeal of this case proceed after the Office's consideration of this paper.

### **CONCLUSION**

All issues having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (202) 824-3156.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 16th day of September, 2008

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